



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Jeffrey H. Price

Serial No.: 09/837,871

Filed: April 17, 2001

For: **MULTIPARALLEL THREE DIMENSIONAL OPTICAL MICROSCOPY SYSTEM**

Group No.: 2878

Examiner: Stephen K. Yam

Docket No. PRICE1220-1

CERTIFICATION UNDER 37 CFR § 1.8

I hereby certify that the documents referred to as enclosed herein are being deposited with the United States Postal Service as first class mail on this date 11 December 2002 in an envelope addressed to:
Assistant Commissioner for Patents, Washington, D.C. 20231

11 December 2002
Date

Terrance A. Meador
Signature

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SUPPLEMENTAL AMENDMENT

Further to the Amendment And Request For Reconsideration submitted in this application on December 5, 2002, Applicants amend the remarks at page 8, lines 6-9, as follows:

"It is further noted that the passage of Campanelli cited to support the rejection of claims 1 and 24, and the associated figure (FIG. 3c) does not set forth a sample volume."

A copy of page 8 with an interlineation showing the correction is attached. The omission of the word "not" in the Amendment was an inadvertent oversight. The undersigned regrets any inconvenience to the Examiner.

The Commissioner is hereby authorized to charge any fees that may be associated with this communication, or credit any overpayment to Deposit Account No. 50-2258. A duplicate copy of this sheet is enclosed.

Respectfully submitted

Terrance A. Meador

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Reg. No. 30, 298

Date: 11 December 2002

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If the "sample volume" and the respective focal planes "in a sample volume" are considered to be inherent, the applicants respectfully request the introduction of extrinsic evidence which clearly shows that the missing subject matter is necessarily present in the bar code reader described in Campanelli and that it would be so recognized by persons of ordinary skill.

It is further noted that the passage of Campanelli cited to support the rejection of claims 1 and 24, and the associated figure (FIG. 3c) does ^{not} set forth a sample volume. Instead, there is only a planar bar code 37 through which light beams are focussed by a lens 38 at different distances. The distances are evidently available in order to provide manual or automatic selection of "a focal plane of interest ...". Campanelli, C. 8, ll. 27-29. So, evidently, Campanelli enables the selection of "a" (single) focal plane. There is no description in connection with this passage, or any illustration in FIG. 3c of Campanelli, that enables "transmitting to the detectors a portion of light originating at the respective focal planes while screening out light which originates from outside of the respective focal planes." Further, Campanelli at C. 8, ll. 23-42, and in FIG. 3c, does not teach or show how a plurality of detectors can be "focussed at a respective focal plane in a sample volume". Campanelli describes only one detector in this context at C. 8, ll. 14, 15. But, the "detector 38" is nowhere illustrated (reference numeral 38 in FIG. 3 denominates a lens) or further described. Accordingly, Campanelli does not enable the subject matter of the rejected claims.

In view of a failure to include all of the subject matter of, and a failure to enable, claims 1, 2, 4-10, 12, 16, 17, and 24, Campanelli does not anticipate these claims.

Claims 3, 11, 13-15, and 18 are rejected for obviousness over Campanelli. That rejection is respectfully traversed for the following reasons.

Prima facie, rejection of a claim for obviousness over a modified reference requires a teaching or suggestion to modify the reference as proposed in the rejection, a reasonable expectation of success, and inclusion in the modified reference of all elements or steps, and limitations thereof recited in the claim. See MPEP 2142, *et seq.*

As already set forth above, Campanelli omits a "sample volume" and respective focal planes "in a sample volume". These limitations are not suggested by Campanelli. Campanelli's problem is to acquire a single, two-dimensional image of a symbol appearing on a label or a surface. The rejected claims are directed to the problem of acquiring an image of a sample volume-a three dimensional object. Accordingly, Campanelli does not satisfy the requirements of *prima facie* obviousness.

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